

Appln. No.	:	10/020,266
Applicant	:	Jeffrey D. Marsh
Filed	:	December 7, 2001
Title	:	APPARATUS AND METHOD OF ON DEMAND PRINTING, BINDING AND TRIMMING A PERFECT BOUND BOOK
TC/A.U.	:	3651
Examiner	:	Patrick Hewey Mackey
Conf. No.	:	1188
Docket No.	:	MARJ 8207US

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313 -1450

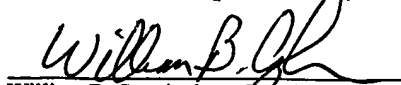
**DECLARATION UNDER 37 CFR §1.131 OF PRIOR INVENTION  
TO OVERCOME CITED PRIOR PATENTS**

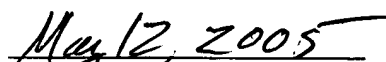
I, the below named Declarant, states and swears as follows:

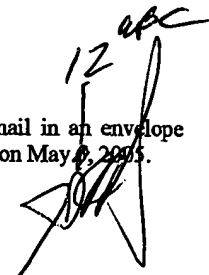
1. My name is Jeffrey D. Marsh and I reside at 7 Country Road, Foristell, MO 63348.

2. I am the sole inventor of the above-identified U.S. Patent Application 10/020,266 for "APPARATUS AND METHOD OF ON DEMAND PRINTING, BINDING AND TRIMMING A PERFECT BOUND BOOK", filed December 7, 2001, Application No. 10/020,266 (the " '266 Application"). This is a continuation in part of U. S. Patent Application No. 09/793,671, filed February 26, 2001 which is a continuation of U. S. Patent Application No. 09/301,918, filed April 29, 1999 (now U. S. Patent 6,193,458), and claims the benefit of my U. S. Provisional Patent Application No. 60/254,106, filed December 8, 2000, and of my U. S. Provisional Patent Application No. 60/281,524 filed April 4, 2001. These applications have not been assigned.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on May 8, 2005.

  
William B. Cunningham, Reg. No. 26,155

  
Date of Signature

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3. I have read and understand the above-identified applications and patents.

4. In the Examiner's action mailed April 13, 2005, Claims 1, 3, 5 – 14, 18 – 24, and 34 – 42 of my pending '266 Application were rejected over U.S. Patent 6,206,358 to Yamaguchi, filed July 14, 1998 and issued March 27, 2001; U.S. Patent 6,416,082 to Gayoso, filed May 23, 2000 and issued July 8, 2002; and U.S. Patent 6,460,843 to Dim et al., filed February 2, 2000 and issued October 8, 2002, hereinafter referred to as the Yamaguchi, Gayoso, and Dim et al. patents, respectively. None of these references issued more than one (1) year prior to the filing date of my U.S. Patent Application No. 10/020,266, December 7, 2001.

5. It is my understanding that the Examiner has determined that the Yamaguchi, Gayoso, and Dim et al. patents substantially show, but do not claim, the subject matter of claims 1, 3, 5 – 14, 18 – 24, and 34 – 42 rejected in the Examiner's action mailed April 13, 2005.

6. I have read and understand the Yamaguchi, Gayoso and Dim et al. patents.

7. Attached is a copy of U.S. Patent 6,142,721, filed January 30, 1998 and issued November 7, 2000. I am the sole inventor of my '721 patent. I have read and understand the disclosure of my '721 patent.

8. My '721 patent discloses the subject matter described in the rejected claims in my '266 Application.

9. Because of the claim of priority, as set out in Paragraph 4, above, with regard to my '266 Application, and particularly because of my two earlier Provisional

A handwritten signature in black ink, appearing to be 'J. A. Dim', is located in the bottom right corner of the page.

Applications, it is my understanding that my '721 patent is not prior art with respect to my '266 application.

10. It is my understanding that the filing of my patent application Serial No. 09/016,156 on January 30, 1998 that issued as my '721 patent is a constructive reduction to practice of the inventions described in my '721 patent. It is further my understanding that a reduction to practice means a completion of an invention.

11. As specifically shown by the Paragraphs below, I conceived and constructively reduced to practice (completed) the subject matter of the rejected claims in my '266 Application this country prior to the filing dates of the Yamaguchi, Gayoso and Dim et al. patents, as listed above in Paragraph 4.

12. In Paragraph 3 of the Examiner's action mailed April 13, 2005 in my '266 application, claims 1, 18 – 24, 36 – 39 and 42 were rejected as being anticipated by Dim et al. under 35 U.S.C. § 102(e). It is my understanding that in order for a claim to be "anticipated", one prior art reference must disclose each and every limitation described in the claim. The examiner pointed out that Dim et al. disclosed the elements of the above rejected claims shown in the left-hand column of the table below. I have reviewed the disclosure of my '721 patent. As shown in the right-hand column of the table below, I point out where that same subject matter is disclosed in my '721 patent.

Disclosure In Dim et al. Relied On By The Examiner	Corresponding Disclosure In Marsh U.S. Patent 6,142,721
Text page printer	"on demand book publishing system 10 may employ one or more black and white page printers, as indicated at 24a, 24b, to print the pages P of a book ..." (Col. 6: lines 12 – 14). Also, see Fig. 5
Cover printer	"Book publishing system 10 may also include a cover printer 40 which may, for example, be a suitable color printer for

	printing a cover blank CB ..." (Col.7: lines 17 – 20), see Fig. 1.
Cover transfer conveyor	"Upon cover C being printed in cover printer 40, the printed cover is conveyed to a cover conditioning station, as indicated at 42, ..." (Col. 9: lines 6 – 8)
An accumulator	"The pages P so printed by each of the printers 24a, 24b are deposited on a respective, generally horizontal bed 26a, 26b as they are fed out of the printers. Upon all of the pages to be printed by a respective printer for the book being printed and deposited on its respective bed 26a or 26b (or both), the bed and the pages are rotated to a generally vertical position, as shown in phantom in FIG. 5, onto a transport conveyor 28. As shown in FIG. 5, bed 26a is pivotally movable about a pivot point PV from a generally horizontal position (as shown in solid lines in FIG. 5) in which it receives pages from its respective page printer 24a to a generally vertical position (as shown in phantom lines in FIG. 5) in which the pages are disposed in a generally vertical position on transport conveyor 28.: (Col. 6: lines 24 – 37).
A carriage	"Bed 26a is pivotally connected to and is movable with a carriage 30 movable which in turn is movable along a horizontal track 32 for transporting the pages P held thereon by bed 26 which serves as a clamp to hold the pages in vertical position on carriage 30 as the carriage moves along track 32 from printer 24a, 24b to ...." (Col. 6, lines 37 – 42).
Adhesive application station	See Figs. 3 and 6.
Binding station	"As shown in FIG. 3, the conditioned cover C is along with the book block 14 are conveyed to a binding station 38 at which the book block is bound within cover C in accordance with the method of the present invention." (Col. 10: Lines 40 – 43) and "Upon cessation of the ultrasonic energy, the adhesive will substantially instantaneously freeze into a solid

	condition this firmly adhering the pages to one another along spine S, adhere the edges of the book block pages P to the inner face of center portion 18 of cover C, and cause the outer face of the book block proximate spine S to bond to the inner face of cover C along the spine." (Col. 11, lines 26 – 32).
Clamp	"Computer COMP also controls operation binding station 38 so as to insert the properly sized cover C between compression rollers 60a, 60b, controls the insertion of book block 14 into the sized cover, controls operation of rollers 60a, 60b to compress cover C onto the lower edge of book block 14, ...." (Col. 12: lines 47 – 52).

13. In Paragraph 4 of the Examiner's action mailed April 13, 2005 in my '266 application, claims 1, 18, 25, 34, 36, 37, and 42 were rejected as being anticipated by Yamaguchi et al. under 35 U.S.C. § 102(e). The examiner pointed out that Yamaguchi et al. disclosed the elements of the rejected claims shown in the left-hand column of the table below. I have reviewed the disclosure of my '721 patent. As shown in the right-hand column of the table below, I point out where that same subject matter is disclosed in my '721 patent.

Disclosure In Yamaguchi et al. Relied On By The Examiner	Corresponding Disclosure In Marsh U.S. Patent 6,142,721
Text page printer	"on demand book publishing system 10 may employ one or more black and white page printers, as indicated at 24a, 24b, to print the pages P of a book ..." (Col. 6: lines 12 – 14). Also, see Fig. 5
An accumulator	"The pages P so printed by each of the printers 24a, 24b are deposited on a respective, generally horizontal bed 26a, 26b as they are fed out of the printers. Upon all of the pages to be printed by a respective printer for the book being

	<p>printed and deposited on its respective bed 26a or 26b (or both), the bed and the pages are rotated to a generally vertical position, as shown in phantom in FIG. 5, onto a transport conveyor 28. As shown in FIG. 5, bed 26a is pivotally movable about a pivot point PV from a generally horizontal position (as shown in solid lines in FIG. 5) in which it receives pages from its respective page printer 24a to a generally vertical position (as shown in phantom lines in FIG. 5) in which the pages are disposed in a generally vertical position on transport conveyor 28.: (Col. 6: lines 24 – 37).</p>
Cover printer	<p>"Book publishing system 10 may also include a cover printer 40 which may, for example, be a suitable color printer for printing a cover blank CB ..." (Col.7: lines17 – 20), see Fig. 1.</p>
Cover transfer conveyor	<p>"Upon cover C being printed in cover printer 40, the printed cover is conveyed to a cover conditioning station, as indicated at 42, ..." (Col. 9: lines 6 – 8)</p>
A carriage	<p>"Bed 26a is pivotally connected to and is movable with a carriage 30 movable which in turn is movable along a horizontal track 32 for transporting the pages P held thereon by bed 26 which serves as a clamp to hold the pages in vertical position on carriage 30 as the carriage moves along track 32 from printer 24a, 24b to ...." (Col. 6, lines 37 – 42).</p>
Adhesive application station	<p>See Figs. 3 and 6.</p>
Binding station	<p>"As shown in FIG. 3, the conditioned cover C is along with the book block 14 are conveyed to a binding station 38 at which the book block is bound within cover C in accordance with the method of the present invention." (Col. 10: Lines 40 – 43) and "Upon cessation of the ultrasonic energy, the adhesive will substantially instantaneously freeze into a solid condition this firmly adhering the pages to one another along spine S, adhere the edges of the book block pages P to the</p>

	inner face of center portion 18 of cover C, and cause the outer face of the book block proximate spine S to bond to the inner face of cover C along the spine." (Col. 11, lines 26 – 32).
Clamp	"Computer COMP also controls operation binding station 38 so as to insert the properly sized cover C between compression rollers 60a, 60b, controls the insertion of book block 14 into the sized cover, controls operation of rollers 60a, 60b to compress cover C onto the lower edge of book block 14, ...." (Col. 12: lines 47 – 52).

14. In Paragraph 6 of the Examiner's action mailed April 13, 2005 in my '266 application, claims 1, 3, 5, 7 – 14, 18 - 24, 34, and 36 - 42 were rejected as being unpatentable over Gayoso in view of Dim et al. The examiner pointed out that Gayoso disclosed the elements of the rejected claims shown in the left-hand column of the table below. I have reviewed the disclosure of my '721 patent. As shown in the right-hand column of the table below, I point out where that same subject matter is disclosed in my '721 patent. Specifically, in Paragraph 6, the examiner stated, "Gayoso discloses a device for printing and perfect binding books including a control system (110); a text printer (122); and a trimmer (144)."

Disclosure In Gayoso Relied On By The Examiner	Corresponding Disclosure In Marsh U.S. Patent 6,142,721
Computer control system	"upon a computer COMP of book publishing system (see FIG. 11) being commanded to print the selected book (which may have any thickness within the above-described predetermined range of book thicknesses), the book page images are transmitted from computer COMP to printers 24a, 24b and these printers print pages P." (Col. 6, lines 17 – 23)
Text page printer	"on demand book publishing system 10

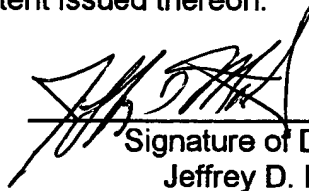
	may employ one or more black and white page printers, as indicated at 24a, 24b, to print the pages P of a book ..." (Col. 6: lines 12 – 14). Also, see Fig. 5
Cover printer	"Book publishing system 10 may also include a cover printer 40 which may, for example, be a suitable color printer for printing a cover blank CB ..." (Col. 7: lines 17 – 20), see Fig. 1.
Trimmer	"In order to trim the bound book, the book is conveyed from binding station 38 to a book trimming station 72, as shown in FIG. 1." (Col. 12, lines 16 – 18).

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Further, Declarant sayeth not.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

05/07/05  
Date

  
\_\_\_\_\_  
Signature of Declarant  
Jeffrey D. Marsh

Attachment - U.S. Patent 6,142,721